

REMARKS

The Application has been carefully reviewed in light of the Office Action dated May 9, 2003 (Paper No. 11). Claims 1 to 52 are in the application, of which Claims 1, 15, 24, 38 and 47 are the independent claims. Claims 1, 15, 24 and 38 are being amended, and Claims 47 to 52 are being added, herein. Reconsideration and further examination are respectfully requested.

By the Office Action, the claims have been rejected under 35 U.S.C. § 103(a). More particularly, Claims 1 to 9, 11 to 14, 16 to 23, 24 to 27, 29 to 37 and 39 to 46 have been rejected over U.S. Patent 5,826,244 (Huberman), U.S. Patent 6,324,521 (Shiota), and Derwent database accession nos. 2000-072115 (Tannenbaum) and 1999-086425 (Murata), Claims 15 and 38 have been rejected over Huberman, Shiota, Tannenbaum and U.S. Patent 5,918,207 (McGovern), and Claims 10 and 28 have been rejected over Huberman, Shiota, U.S. Patent 5,974,401 (Enomoto) and Tannenbaum.

The present invention relates to a virtual market place for providing print services, such as photo print services, over a computer network. According to the present invention, a virtual print market place comprises an interactive shop, patrons of the interactive shop, and a service provider. In the virtual print market place, information concerning print services and pricing information provided by service providers is collected, together with selection criteria provided by the interactive shop. The interactive shop offers products and services identified in the virtual market place to patrons of the interactive shop. A patron of the interactive shop selects from the products and services offered by the interactive shop. The services selected by the patrons of the interactive print

shop are supplied by service providers selected based on the selection criteria supplied by the interactive shop. In the virtual print market place, relationships between interactive shops and suppliers are established via the market portal, prior to or after selection of a service by a patron of an interactive shop, to provide the services to patrons of the interactive shop.

By this arrangement, relationships can be established between interactive shops and service providers to provide the services, and the interactive shop is in turn able to offer to patrons of the interactive shop products and/or services identified in the virtual print market place.

Turning to the specific language of the claims, Claim 1 concerns a method of creating a virtual print market place over a network. Market information is collected, which comprises an identity of service providers and the print services and pricing provided by each of the service providers. In addition, criteria is obtained, which is established by an interactive shop for selecting service providers to provide the print services. One or more service providers identified in the market information are selected to provide the set of print services based on the criteria and the market information. The interactive shop offers products and/or services identified in the virtual print market place to patrons of the interactive shop.

The applied art, namely Huberman, Shiota, Tannenbaum and Murata, is not seen to teach or to suggest a virtual print market place, in which service providers and interactive shops supply market information and selection criteria, respectively, wherein the interactive shop offers products and/or services identified in the virtual print market place to patrons of the interactive shop, and one or more service providers are selected

based on market information collected, and selection criteria obtained, to provide the products/services.

Huberman is seen to describe a broker that receives bids from a customer and a supplier and then the broker selects the supplier based on received bids. In the case that the customer initiates the bidding, the customer communicates its request for a suppliers services to the broker who then selects the particular supplier. The broker then supplies the customer with the supplier information so that the customer can accept or decline the transaction involving the supplier, or suppliers, selected by the broker. Accordingly, the broker acts as an intermediary that accepts bids from customers and suppliers and makes a selection from the received bids.

More particularly, the cited portions of Huberman (i.e., col. 3, line 41 to col. 4, line 23, col. 4, line 45 to col. 5, line 32, col. 8, lines 51 to 65, and col. 13, line 54 to col. 14, line 46) are seen to describe an auction in which a customer that needs a document service submits a request, suppliers of the service submit bids, and the broker selects one or more suppliers and gives the customer the opportunity to accept or decline the transaction involving the supplier(s) selected by the broker.

Thus, Huberman is seen to merely describe a broker that establishes a transactional relationship between a customer and a supplier, in which the supplier supplies products/services to the customer. Nothing in Huberman is seen to teach or to suggest a virtual print market place, in which service providers and interactive shops supply market information and selection criteria, respectively, wherein the interactive shop offers products and/or services identified in the virtual print market place to patrons of the

interactive shop, and one or more service providers are selected based on market information collected, and selection criteria obtained, to provide the products/services.

Shiota is not seen to remedy the deficiencies of Huberman. More particularly, Shiota is seen to describe a networked photographic service system consisting of “over-the-counter” minilabs and a center server. As Shiota is understood, a customer in the system brings pictures to an “over-the-counter” minilab for uploading to the center server. The customer then accesses the center server’s web page to order prints via the center server’s web site, and the center server selects one of the minilabs to fulfill the customer’s order. (See col. 1, line 56 to col. 6, line 41, col. 7, lines 2 to 57, col. 8, line 31 to col. 9, line 40 and Figure 5 of Shiota..)

Accordingly, Shiota is seen to describe a plurality of minilabs connected via a server that is accessed by a customer to order prints from one of the minilabs. Shiota is not seen to teach or to suggest a virtual print market place, in which service providers and interactive shops supply market information and selection criteria, respectively, wherein the interactive shop offers products and/or services identified in the virtual print market place to patrons of the interactive shop, and one or more service providers are selected based on market information collected, and selection criteria obtained, to provide the products/services.

The remaining references, namely Tannenbaum and Murata, have been carefully reviewed and are not seen to teach or to suggest a virtual print market place, in which service providers and interactive shops supply market information and selection criteria, respectively, wherein the interactive shop offers products and/or services identified in the virtual print market place to patrons of the interactive shop, and one or more service

providers are selected based on market information collected, and selection criteria obtained, to provide the products/services.

Therefore, for at least the foregoing reasons, Claim 1 is believed to be in condition for allowance. Further, Applicants submit that Claim 24 is believed to be in condition for allowance for at least the same reasons.

Claim 15 is directed to a method of creating a virtual print market place over a network. Market information comprising an identity of service providers, interactive shops, a standardized set of print services and pricing provided by each of the service providers is collected, a bid is obtained from a service provider that identifies a print service and terms for providing the print service, and a bid is obtained from an interactive shop identifying the print service and terms for purchasing the print service. Compatibility between the service provider and the interactive shop is determined, and an agreement is established between the service provider and the interactive shop when the terms of the print service and the interactive shop are compatible. According to one feature of the claim, the interactive shop offers products and/or services identified in the virtual print market place to patrons of the interactive shop.

Based on the above discussion, the applied art, taken alone or in any permissible combination, is not seen to teach or to suggest to teach or to suggest a virtual print market place, in which compatibility between a service provider and an interactive shop is determined and an agreement is established between the service provider and the interactive shop when the terms for providing the print service by the service provider and the terms for purchasing the print service by the interactive shop, wherein in the virtual

print market place the interactive shop offers products and/or services identified in the virtual print market place to patrons of the interactive shop.

It is stated, commencing at page 4, in the Office Action that Huberman, Shiota, and Tannenbaum fail to teach the feature of determining compatibility. The Office Action cites McGovern as disclosing this feature. It is submitted, however, that none of the applied art, and in particular McGovern, is seen to teach or to suggest a virtual print market place which determines compatibility between a service provider providing a print service and an interactive shop purchasing a print service, wherein the interactive shop offers products and/or services to patrons of the interactive shop.

McGovern is seen to describe a resource planning tool used by a service provider to identify a work force with backgrounds to meet the resource needs of its customers. (See McGovern, Abstract and col. 2, lines 3 to 60.) This is not seen to teach or to suggest a virtual print market place which determines compatibility between a service provider providing a print service and an interactive shop purchasing a print service, wherein the interactive shop offers products and/or services to patrons of the interactive shop.

Therefore, for at least the foregoing reasons, Claim 15 is believed to be in condition for allowance. Further, Applicants submit that Claim 38 is believed to be in condition for allowance for at least the same reasons.

New Claims 47 and 48 include a method of providing services from a service provider to a client device, the steps of which are performed by a server which is connected to the service provider and the client device. The steps of the method performed by the server comprise collecting market information including the identify of a plurality of

service providers and the services provided by each, selecting of one or more service providers based on a request from the client device, and offering the selected service providers and/or services to the client device. In addition to the server, Claim 48 has the added features of an interactive shop which establishes criteria for selecting the one or more service providers and/or services.

The applied art is not seen to disclose or to suggest these features of Claims 47 and 48. Therefore, Claims 47 and 48 are believed to be in condition for allowance.

New Claims 49 to 52 include the feature of an intermediary to the service provider that provides print services and the interactive shop that offers products and/or services to patrons of the interactive shop. According to Claims 49 and 51, the intermediary collects market information from service providers, obtains selection criteria from the interactive shop and selects one or more service providers based on the market information and selection criteria. According to Claims 50 and 52, the intermediary collects market information, obtains bids from service providers and interactive shops, determines a compatibility between a service provider and an interactive shop, and establishes an agreement between a compatible service provider and an interactive shop such that the service provider provides a service and the interactive shop agrees to purchase the service.

The applied art is not seen to disclose or to suggest these features of Claims 49 to 52. Therefore, Claims 49 to 52 are believed to be in condition for allowance.

The remaining claims are each dependent from the independent claims discussed above and are therefore believed patentable for the same reasons. Because each dependent claim is also deemed to define an additional aspect of the invention, however,

the individual consideration of each on its own merits is respectfully requested.

In view of the foregoing, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

INFORMATION DISCLOSURE STATEMENT

In compliance with the duty of disclosure under 37 C.F.R. § 1.56 and in accordance with the practice under 37 C.F.R. §§ 1.97 and 1.98, the Examiner's attention is directed to the documents listed below and on the enclosed Form PTO-1449. Copies of each of these documents are enclosed.

- (1) U.S. Patent No. 5,732,400
- (2) U.S. Patent No. 5,943,408
- (3) U.S. Patent No. 6,055,512
- (4) U.S. Patent No. 6,208,857
- (5) U.S. Patent No. 6,430,178
- (6) U.S. Patent No. 6,598,026
- (7) GB 2,334,176
- (8) WO 98/20698
- (9) JP 10-320321
- (10) Derwent Acc. No. 1999-086425
- (11) Derwent Acc. No. 1999-397565
- (12) Derwent Acc. No. 2000-072115
- (13) Derwent Acc. No. 2000-349479

Documents (4) and (10) to (13) were discussed in the Office Action but were not formally made of record in the Notice of References Cited accompanying the Office Action, referred to herein as the Form PTO-892. Documents (4) and (8) are listed as equivalents in the "Patent Family" section of Derwent acc. no. 1998-287431, which was made formally of record in the Form PTO-892.

Document (2) is listed in the "Patent Family" section of Derwent acc. nos. 1997-492642, which was made of record in the Form PTO-892, as a U.S. equivalent of GB 2,312,594, which was also made of record in the Form PTO-892.

Documents (10) and (13) are Derwent/Dialog database listings including Abstracts of documents (9) and (3), respectively. Document (11) is a Derwent/Dialog database listing including an Abstract of document (7), and document (5) is listed in document (11) as a U.S. equivalent of document (7) in the "Patent Family" section of document (11).

With respect to documents (1) and (6), it is hereby certified, in accordance with 37 C.F.R. § 1.97(e)(2), that this information was not cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of Applicants' undersigned attorney after making a reasonable inquiry, was not known to any individual designated in § 1.56(c) more than three months prior to the filing of this Information Disclosure Statement.

It is noted that the subject application has received a final action under 37 C.F.R. § 1.113. Accordingly, enclosed is a check for the required fee of \$180.00 to cover the Information Disclosure Statement under 37 C.F.R. 1.97(c)(2). Consideration of the art cited herein is accordingly deemed proper, and such action is respectfully requested.

Additionally, the Examiner is requested to indicate that this information has been considered by initialing the appropriate portion of Form PTO-1449.

CONCLUSION

Applicants' undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,


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